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In re Application of :  
DEL SOLDATO, Piero *et al* :  
U.S. Application No.: 10/501,335 :  
PCT No.: PCT/EP03/00394 :  
Int. Filing Date: 16 January 2003 :  
Priority Date: 29 January 2002 :  
Attorney Docket No.: 026220-00048 :  
For: NEW CORTICOSTEROIDS :

## DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.47(a)" filed with the United States Designated/Elected Office (DO/EO/US) on 20 May 2005.

## BACKGROUND

On 11 April 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a \$65.00 surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 20 May 2005, applicants filed the subject petition which was accompanied by, *inter alia*, a \$130.00 petition fee; an affidavit of Maria Teresa Noro; the surcharge fee; a declaration signed by one of the two joint inventors; copies of letters dated 14 February 2005 and 29 March 2005 with English translations; a copy of postal receipts; and authorization to charge any additional fees to Deposit Account No. 01-2300.

## DISCUSSION

Petitioners claim that joint inventor Piero Del Soldato "refuses to join in the application" and have submitted a petition under 37 CFR 1.47(a) in response to the Form PCT/DO/EO/905 mailed 11 April 2005. A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the non-signing joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the non-signing joint inventor.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. Here, petitioners submitted a \$130.00 petition fee. The \$70.00 difference will be charged to Deposit Account No. 01-2300 as authorized.

With regards to item (3), the 37 CFR 1.47(a) applicant claims that the last known address of Mr. Piero Del Soldato is:

Via Enrico Toti 22  
Monza, MI 20052  
Italy

Regarding item (4), the 37 CFR 1.47(a) applicant provided a declaration signed by one of the two joint inventors for the nonsigning joint inventor pursuant to section 409.03(a) of the Manual of Patent Examining Procedure (MPEP). The declaration lists the citizenship, residence and mailing address of the two inventors and complies with 37 CFR 1.497(a) and (b). Petitioners also submitted the \$65.00 surcharge fee.

Accordingly, items (1), (3), (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), the 37 CFR 1.47(a) petitioner included a declaration by attorney Maria Teresa Noro who explains that the nonsigning inventor has an ongoing legal dispute with Nicox S.A. for his dismissal on 02 April 2004 and his right for additional compensation. Ms. Noro states that she "has been in touch on a frequent basis with Mr. Fabrizio Conte of the Milan Bar, the lawyer who is assisting Mr. Piero Del Soldato."

Ms. Noro claims that a complete copy of the application was sent registered mail to Mr. Del Soldato at his home on 14 February 2005 with a copy "hand delivered" to his attorney, Mr. Conte, for his review. Petitioners provided a copy of this letter along with an English translation. However, these documents were never delivered to Mr. Del Soldato and were returned by postal authorities. Another set of papers were sent to Mr. Del Soldato at the same address on 29 March 2005 with another copy hand-delivered to his lawyer. Ms. Noro claims that these papers were delivered to Mr. Del Soldato but no response has been received.

A careful review of the evidence shows that petitioners have not yet satisfied the requirements of item (2) of 37 CFR 1.47(a). It is not clear that the address listed for Mr. Del Soldato is still good. There is no direct evidence that Mr. Del Soldato received the documents. The postal receipts are in Italian without an accompanying English translation and the postal receipt for the 29 March 2005 documents in which Ms. Noro claims to have been received is not signed by Mr. Del Soldato.

Nevertheless, petitioners would still have satisfied item (2) by showing that Mr. Del Soldato's lawyer received the documents purportedly hand-delivered on 14 February 2005 and 29 March 2005. But petitioners have provided no proof that the documents were received by Mr. Conte. A declaration or affidavit by the courier who hand-delivered these documents would be sufficient, or a response to an email could also suffice.

For these reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

**CONCLUSION**

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT



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